



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

ROBERT G. LANE et al.

Serial No.: 09/688,784

Group Art Unit: 2664

Filed: October 16, 2000

Examiner: not known

For: Information Network Virtual Backplane

RECEIVED

Attorney Docket No.: 99-002-NSC (STK99002PUS)

APR 04 2001

**DECLARATION OF FACTS
PERTAINING TO DILIGENT EFFORT
IN OBTAINING INVENTOR SIGNATURES**

OFFICE OF PETITIONS

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

This declaration has been prepared to show diligent effort, required under 37 C.F.R. § 1.47, in attempting to obtain signatures from Mark A. Bakke and Timothy J. Kuik, named inventors on the above-mentioned patent application. This declaration was prepared in response to a Notice of Missing Parts mailed November 28, 2000.

The following facts are stated to the best of my recollection:

Storage Technology Corporation (StorageTek) and Cisco Systems, Inc. (Cisco) are involved in litigation. For a suit filed in Minnesota, attorneys for Cisco moved to disqualify attorneys from Brooks & Kushman, P.C., the law firm for which I am employed. At the request of an attorney at Brooks & Kushman, I was asked to prepare a Declaration summarizing my involvement with Mr. Bakke and Mr. Kuik. This Declaration is included as Exhibit I. Attached to Exhibit I are the following Exhibits:

Exhibit A: A letter, dated September 28, 2000, which accompanied a draft of the application sent to Mr. Bakke and Mr. Kuik.

Exhibit B: A redacted email message, dated October 19, 2000, from Mr. Kuik to me after his review of the draft patent application.

On December 28, 2000, I mailed a copy of the above-mentioned application, together with a declaration and an assignment, to Mr. Bakke and Mr. Kuik. A copy of the

cover letter is appended as Exhibit II. Copies of Federal Express Airbills for delivery to Mr. Bakke and Mr. Kuik are appended as Exhibits III and IV, respectively.

On January 19, 2001 I received a telephone call from Joe Hammell, who identified himself as an attorney from Dorsey & Whitney representing Cisco. Mr. Hammell asked me to have no further contact with any former StorageTek employee now working for Cisco. Mr. Hammell also indicated that he would send a letter indicating that no former StorageTek employee currently working for Cisco would sign any document related to a StorageTek patent application. I told Mr. Hammell that I would forward a copy of this letter to the U.S. Patent and Trademark Office as evidence that inventors now working for Cisco were unwilling to sign patent application declarations.

After having received no letter from Mr. Hammell, I sent him a letter on February 23, 2001. This letter summarized our telephone conversation, including my understanding that Mr. Kuik and Mr. Bakke refused to sign any declaration or assignment. A copy of this letter is appended as Exhibit V.

Mr. Hammell responded by letter on March 2, 2001, appended as Exhibit VI. In this letter, he stated that Mr. Kuik and Mr. Bakke "were not willing to execute the particular Declarations and Assignments [that I] had sent them, in part because of concerns on their part that such documents contained possibly inaccurate information." Mr. Hammell did not elaborate on what Mr. Kuik and Mr. Bakke believed to be inaccurate.

In his letter of March 2, 2001, Mr. Hammell made several inaccurate statements about our telephone conversation and about my conduct with regards to Mr. Bakke and Mr. Kuik. In particular, Mr. Hammell asserted that my contacts with Mr. Bakke and Mr. Kuik "constituted serious ethical breaches." Mr. Hammell attempted to use this argument in a motion to have attorneys at Brooks & Kushman disqualified from litigation between StorageTek and Cisco. This motion was decided against Mr. Hammell's position by Susan R. Nelson, United States Magistrate Judge, on March 13, 2001. The resulting opinion is appended as Exhibit VII. In this opinion, Judge Nelson stated the following at page 12:

Mr. Chuey's September and December telephone correspondence and letter correspondence do not present a basis for disqualification. (Chuey Aff., Doc. No. 20, ¶¶6, 7, 8, 12.) All of Mr. Chuey's contacts with Mr. Bakke were made in effort

to secure Mr. Bakke's signature on patent applications for patents developed during Mr. Bakke's employment at StorageTek. In addition, Cisco's legal department was aware that StorageTek was seeking Mr. Bakke's signature on the patent applications. (Kuik Aff., Doc. 17, Ex. C.) Mr. Chuey's contacts with Mr. Bakke did not violate [Minnesota Rule of Professional Conduct] 4.3, and therefore cannot provide a basis for disqualification.

Based on the above facts, I believe that I have diligently attempted to obtain signed Declarations from Mr. Bakke and Mr. Kuik.

Respectfully submitted,



Mark D. Chuey
Reg. No. 42,415

Date: March 28, 2001

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